



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/795,893	03/08/2004	Ken Kalnoski	263497US8	1528
22850 7590 05/14/2010 OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, L.L.P. 1940 DUKE STREET ALEXANDRIA, VA 22314				
EXAMINER LOFTIS, JOENNA RONEE				
ART UNIT 3624		PAPER NUMBER		
NOTIFICATION DATE 05/14/2010		DELIVERY MODE ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patentdocket@oblon.com
oblonpat@oblon.com
jgardner@oblon.com

Office Action Summary

Application No.

10/795,893

Applicant(s)

KALINOSKI, KEN

Examiner

JOHNNA R. LOFTIS

Art Unit

3624

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 February 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4, 6-18 and 20-31 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4, 6-18, 20-31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB-08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. The following is a non-final office action upon examination of application number 10795893. Claims 1-4, 6-18 and 20-31 are pending and have been examined on the merits discussed below.

Response to Arguments

2. Applicant's arguments filed with respect to previous rejections under 35 USC 112 have been fully considered but they are not persuasive. The cited portion of the specification is open ended and does not convey that the inventor intended to exclude meeting attendees and meeting locations from the list of resources. As recited in the specification, "in addition, other types of heterogeneous resources may be included based on the needs of scheduled or anticipated meetings". This statement does not inherently exclude the meeting attendees and locations. Examiner suggests amending the claims to include "consisting of" language wherein the claims positively recite what is included as opposed to claiming what is excluded.
3. Applicant's arguments filed with respect to previous rejections of claims 13-18 and 20 under 35 USC 101 have been fully considered but they are not persuasive. While the method claims do include an interface and databases, the storage and display of data is not enough to meet the standards of 35 USC 101. See the rejection under 35 USC 101 below.
4. Applicant's arguments, with respect to previous rejections under 35 USC 101 of claims 1-4, 6-12 and 21-31 have been fully considered and are persuasive. The rejection under 35 USC 101 of claims 1-4, 6-12 and 21-31 has been withdrawn.

5. Applicant's arguments with respect to claims 12-18 and 20 have been considered but are moot in view of the new ground(s) of rejection.
6. Examiner would like to note, regarding the rejection under 112, that the rejections of the system claims are upheld in view of Capek. Since the functionality of the system does not change based on the data in the database, Examiner is upholding those rejections of the system claims in view of Capek. Merely labeling the data in different ways does not change the overall functionality of the structure.

Claim Rejections - 35 USC § 112

7. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

8. Claims 1-4, 6-18 and 20-31 rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Specifically, claims are directed to scheduling meetings using resources "other than meeting attendees and meeting locations". Support is not found in the specification for such limitations.

Claim Rejections - 35 USC § 101

9. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

10. Claims 13-18 and 20 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Based on Supreme Court precedent and recent Federal Circuit decisions, the Office's guidance to examiners is that a § 101 process must (1) be tied to another statutory class (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing. *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780,787-88 (1876); *In re Bilski*, 88 USPQ2d 1385 IFed. Cir. 2008). Also see USPTO Memoranda, "Guidance for Examining Process Claims in view of *In re Bilski*," January 7, 2009 and "New Interim Patent Subject Matter Eligibility Examination Instructions," August 24, 2009. Both memoranda may be located on the USPTO website at:

<http://www.uspto.gov/web/patents/memoranda.htm>

There are two corollaries to the machine-or-transformation test. First, a mere field of use limitation is generally insufficient to render an otherwise ineligible method claim patentable. This means the machine or transformation must impose meaningful limits on the method claim's scope to pass the test. Second, insignificant extra solution activity will not transform an unpatentable principle into a patentable process. This means reciting a specific machine or particular transformation of a specific article in an insignificant step, such as data gathering or outputting, is not sufficient to pass the test. If neither of these requirements are met by the

claims, the method is not a patent eligible process under 35 USC 101 and is non-statutory subject matter.

Nominal recitations of structure in an otherwise ineligible method fail to make the method a statutory process. The use of a specific machine or transformation of an article must impose meaningful limits on the claim's scope to impart patent-eligibility. See *Benson*, 409 U.S. at 71-72. Further, the involvement of the machine or transformation in the claimed process must not merely be insignificant extra-solution activity. See *Flook*, 437 U.S. at 590. Incidental physical limitations, such as data gathering, field of use limitations, and extra-solution activity is not enough to convert an abstract idea into a statutory process (*In re Bilski*, 88 USPQ2d 1385, 1385 (*Fed Cir.* 2008)). In other words, nominal or token recitations of structure in a method claim do not convert an otherwise ineligible claim into an eligible one. It is further noted that the mere recitation of a machine in the preamble in a manner such that the machine fails to patentably limit the scope of the claim does not make the claim statutory under 35 USC 101, as seen in the Board of Patent Appeals Informative Opinion *Ex Parte Langemyr et al.* (*Appeal 2008-1495*).

Regarding the "transformation" prong, the parameters, capabilities and "risk" provided by the claimed invention do not represent physical and tangible objects. Rather, the claimed parameters, capabilities and "risk" represent conceptual and theoretical values. This is different than the discussion of *Abele* held by *Bilski*, in which "X-ray attenuation data produced in a two dimensional field by a computed tomography scanner" was deemed to represent physical and tangible objects, because it "clearly represented physical and tangible objects, namely the structure of bones, organs, and other body tissues..... the transformation of that raw data into a

particular visual depiction of a physical object on a display”, resulting in a transformation of data that rendered the process patent-eligible. Thus, the claimed invention does not rise to the level of Abe in transforming electronically-manipulated data into patent-eligible subject matter.

Here, applicant’s method steps, fail the first prong since they include only nominal recitations of structure. Similarly, the applicant’s method steps fail the second prong because they do not result in a transformation of subject matter into another state or thing. Thus, claims 13-18 and 20 are non-statutory.

Claim Rejections - 35 USC § 102

11. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

12. Claims 1-4, 6, 8-12, 21-25, and 27-31 are rejected under 35 U.S.C. 102(a and c) as being anticipated by Capek et al, US 7,343,312.

As per claim 1, Capek et al teaches a user interface operable to accept meeting constraints (column 3, lines 6-56; column 7, lines 40+); a resource properties database storing schedules for the heterogeneous resources other than meeting attendees and meeting locations, each resource having associated properties (column 4, lines 19-32); a scheduled events database storing schedules for the heterogeneous resources (column 4, lines 19-32); a configuration engine interfaced with the user interface and resource properties database, the configuration engine operable to apply the meeting constraints and the resource properties to priority rules that generate an ordered list of heterogeneous resource sets, each set having a valid configuration that satisfies the meeting constraints (column 4, lines 1-36 – optimization of meeting variables based on weights); an availability engine interfaced with the configuration engine and the scheduled events database, the availability engine operable to select heterogeneous resources from the ordered list based on the scheduled availability of resources (column 4, lines 29-32); and identifying resources of the priority list that are unavailable to satisfy meeting constraints due to a scheduled use; and monitoring the unavailable resources for subsequent availability to satisfy the meeting constraints (column 7, lines 40-49 – availability is monitored for optimization of the schedule).

As per claim 2, Capek et al teaches the configuration engine is further operable to order the list of heterogeneous resources according to a cost function, the list ordered with the greatest priority given to the set of heterogeneous resources having the least cost to satisfy meeting

constraints (column 3, lines 56-67; column 10, lines 48-50 – traditional optimization of variables based on constraints; includes minimization of costs).

As per claim 3, Capek et al teaches the configuration engine cost function adjusts to user-selected weights for one or more meeting constraints (column 7, lines 40-49 – constraints; column 10, lines 48-50 min. cost).

As per claim 4, Capek et al teaches the user-selected weights comprise one or more of meeting timing capacity and locality (column 7, lines 40-49 – constraints)

As per claim 6, Capek et al teaches an access controller interfaced with the availability engine and the resource properties database, the access controller operable to restrict scheduling of one or more resources having limited access properties (column 4, lines 19-32 – resource availability).

As per claim 8, Capek et al teaches the access controller is further operable to override a scheduled use of a resource to satisfy meeting constraints having a predetermined priority (column 10, lines 11-26).

As per claim 9, Capek et al teaches a reschedule engine operable to automatically reschedule overridden scheduled uses (column 10, lines 11-26).

As per claim 10, Capek et al teaches a notification engine interfaced with the availability and reschedule engines, the notification engine operable to automatically notify attendees of a meeting scheduled according to a set of resources of the ordered list and to automatically notify attendees of rescheduling (column 4, lines 50-57 – notifications and column 10, lines 11-26 – changes to schedules)

As per claim 11, Capek et al teaches a resource engine interfaced with the scheduled events database and the heterogeneous resources, the resource engine operable to initiate, terminate and track use of the heterogeneous resources in compliance with the schedule (column 4, lines 23-32 – schedules and monitors use of resources/equipment).

As per claim 12, Capek et al teaches the heterogeneous resources comprise at least video conference resources, audio conference resources and network resources (column 4, lines 19-31).

As per claim 21, Capek et al teaches a user interface operable to accept meeting constraints (column 3, lines 6-56; column 7, lines 40+); a resource properties database storing schedules for the heterogeneous resources (column 4, lines 19-32); a scheduled events database storing schedules for the heterogeneous resources (column 4, lines 19-32); a configuration engine interfaced with the user interface and resource properties database, the configuration engine operable to apply the meeting constraints and the resource properties to priority rules that generate an ordered list of heterogeneous resource sets, each set having a valid configuration that satisfies the meeting constraints (column 4, lines 1-36 – optimization of meeting variables based on weights); an availability engine interfaced with the configuration engine and the scheduled events database, the availability engine operable to select heterogeneous resources from the ordered list based on the scheduled availability of resources (column 4, lines 29-32); and an access controller interfaced with the availability engine and the resource properties database, the access controller operable to restrict scheduling of one or more resources having limited access properties (column 4, lines 19-32 – resource availability).

As per claim 22, Capek et al teaches the configuration engine is further operable to order the list of heterogeneous resources according to a cost function, the list ordered with the greatest

priority given to the set of heterogeneous resources having the least cost to satisfy meeting constraints (column 3, lines 56-67; column 10, lines 48-50 – traditional optimization of variables based on constraints; includes minimization of costs).

As per claim 23, Capek et al teaches the configuration engine cost function adjusts to user-selected weights for one or more meeting constraints (column 7, lines 40-49 – constraints; column 10, lines 48-50 min. cost).

As per claim 24, Capek et al teaches the user-selected weights comprise one or more of meeting timing capacity and locality (column 7, lines 40-49 – constraints)

As per claim 25, Capek et al teaches identifying resources of the priority list that are unavailable to satisfy meeting constraints due to a scheduled use; and monitoring the unavailable resources for subsequent availability to satisfy the meeting constraints (column 7, lines 40-49 – availability is monitored for optimization of the schedule).

As per claim 27, Capek et al teaches the access controller is further operable to override a scheduled use of a resource to satisfy meeting constraints having a predetermined priority (column 10, lines 11-26).

As per claim 28, Capek et al teaches a reschedule engine operable to automatically reschedule overridden scheduled uses (column 10, lines 11-26).

As per claim 29, Capek et al teaches a notification engine interfaced with the availability and reschedule engines, the notification engine operable to automatically notify attendees of a meeting scheduled according to a set of resources of the ordered list and to automatically notify attendees of rescheduling (column 4, lines 50-57 – notifications and column 10, lines 11-26 – changes to schedules)

As per claim 30, Capek et al teaches a resource engine interfaced with the scheduled events database and the heterogeneous resources, the resource engine operable to initiate, terminate and track use of the heterogeneous resources in compliance with the schedule (column 4, lines 23-32 – schedules and monitors use of resources/equipment).

As per claim 31, Capek et al teaches the heterogeneous resources comprise at least video conference resources, audio conference resources and network resources (column 4, lines 19-31).

Claim Rejections - 35 USC § 103

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

14. Claim 7 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Capek et al, US 7,343,312.

As per claims 7 and 26, Capek et al teaches the limited access property comprises an authorization code to exceed a predetermined cost associated with resource use (column 10, lines 48-50). Official notice is taken that it is old and well known to authorize excess spending in certain situations. It would have been obvious to one of ordinary skill in the art at the time of the invention to include this authorization in Capek et al. As the optimization takes place it is inevitable that if other variables are optimized, the minimization of costs may suffer and due to budget concerns of any company, it would be obvious to authorize excess spending.

15. Claims 13-16 and 20 rejected under 35 U.S.C. 103(a) as being unpatentable over Capek et al, US 7,343,312, in view of Shaffer et al, US 7213050

16. As per claim 13, Capek et al teaches identifying schedule constraints associated with the meeting (column 3, lines 6-56; column 7, lines 40+); ordering in priority a list of plural sets of candidate heterogeneous resources, each set having a valid configuration that satisfies the scheduling constraints (column 4, lines 1-36 – optimization of meeting variables based on weights); selecting a set of heterogeneous resources from the ordered list; scheduling the heterogeneous resources to support the meeting (column 4, lines 1-36 – optimization of meeting variables based on weights); automatically notifying attendees (column 4, lines 50-57 – notifications); automatically initiating one or more the heterogeneous resources according to the schedule (column 4, lines 1-36 – optimization of meeting variables based on weights – resources are scheduled for use); and limiting access to predetermined heterogeneous resources according to one or more required authorizations (column 9, lines 60-67 – attendees have weighting factors indicating who is more important to the scheduling process).

Capek et al does not explicitly teach the heterogeneous resources are those other than meeting attendees and meeting locations. Shaffer et al discloses a conference reservation system wherein audio and video conference resources are considered for scheduling purposes. These resources include, for example, network resources, such as bandwidth, and MCU resources. Shaffer et al shows that the consideration of resources other than attendees and locations was known in the prior art at the time of the invention.

Since each individual element and its function are shown in the prior art, albeit shown in separate references, the difference between the claimed subject matter and the prior art rests not on any individual elements or function but in the very combination itself - that is the substitution of the network resource data of the secondary reference for the attendee and location data of the Capek reference. Thus, the simple substitution of one known element for another producing a predictable result renders the claim obvious

As per claim 14, Capek et al teaches identifying one or more biasing weights associated with one or more schedule constraints; and ordering the priority list according to the biasing weights (column 7, lines 40-49 – optimization with consideration of constraints)

As per claim 15, Capek et al teaches estimating a cost associated with each set of heterogeneous resources; and providing greater priority to sets having smaller costs (column 7, lines 40-49 – constraints; column 10, lines 48-50 min. cost).

As per claim 16, Capek et al teaches associating one or notification parameters with each attendee; and selecting one or more notification medium for each attendee based on the notification parameters associated with the attendee (column 4, lines 47-57 – attendees authorize automatic entry into a calendar).

As per claim 20, Capek et al teaches the heterogeneous resources comprise at least video conference, audio conference and network resources (column 4, lines 19-31).

17. Claims 17 and 18 rejected under 35 U.S.C. 103(a) as being unpatentable over Capek et al, US 7,343,312, in view of Shaffer et al, US 7,213,050, further in view of admitted prior art (as admitted based on the office action dated 11/5/08).

As per claim 17, Capek et al teaches the notification medium includes email, instant message or other means and since the system accommodates for telephonic communication (column 9, lines 20-26), but does not explicitly teach using a telephone to send a computer generated voice reminder. Applicant Admission is noted that utilization of a telephone to send a computer generated voice reminder is old and well known. Therefore it would have been obvious to modify the combination of Capek et al and Shaffer et al to incorporate computer generated voice reminders. The modification of the combination with functionally equivalent equipment would produce a predictable result.

As per claim 18, Capek et al teaches the notification medium includes email, instant message or other means and since the system accommodates for telephonic communication (column 9, lines 20-26), but does not explicitly teach the notification further comprises cell phone call with in a predetermined time of the scheduled meeting. Applicant Admission is noted that utilization of a cell phone call as a reminder is old and well known in the art. Therefore, it would have been obvious to one of ordinary skill in the art to modify the combination of Capek et al and Shaffer et al to utilize a cell phone call as a reminder. The modification of the combination with functionally equivalent equipment would produce a predictable result

Conclusion

18. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Jurkevics et al, US 5978463 – reservation scheduling system for audio conferencing resources

Shaffer et al, US 7035230 – system and method for bandwidth and conference resource reservation

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JOHNNA R. LOFTIS whose telephone number is (571)272-6736. The examiner can normally be reached on M-F 8am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Beth Boswell can be reached on 571-272-6737. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Johnna R Loftis/
Examiner, Art Unit 3624